

REMARKS

This Amendment is submitted in response to the Office Action dated November 20, 2004, having a shortened statutory period set to expire January 20, 2005. Claims 1-5 are pending. No amendments to the claims have been made.. No new matter has been entered by these amendments.

Specification

The abstract of the disclosure has been objected to. Applicants have amended the specification and believe that such amendment overcomes the objection.

Claim Rejections Under 35 U.S.C. §102

Claims 1-5 have been rejected under 35 U.S.C. §102(e) as being anticipated by *Dubrovskiy, et al* (U.S. Patent No. 6,050,879). That rejection is respectfully traversed and reconsideration of the claims is requested.

Exemplary Claim 1 in the present application recites the novel step of:

(e) dispensing a non-abrasive liquid between the air bearing surface and the lapping plate

On page 3 of the present Office Action, the Examiner presents as evidence that this step is disclosed by *Dubrovskiy* the following statement:

“dispensing a non-abrasive liquid (equivalent with free or no abrasive particles) between the air bearing surface and the lapping surface (see also col. 7 and 8 of Claims 1-5)”

The Examiner thus sets forth as evidence that this step of the present invention is shown or inherent in *Dubrovskiy* the *Dubrovskiy* teaching of an abrasive liquid being used in the lapping process and that this is somehow “equivalent”. As a second basis for considering this step anticipated by *Dubrovskiy*, the Examiner references cols. 7 and 8 of Claims 1-5.

With respect to the Examiner’s position that a non-abrasive liquid is “equivalent” to an abrasive liquid, Applicants respectfully point out that these two liquids are, by definition,

opposites and not equivalents. Moreover, *Dubrovskiy* discusses the use of abrasive liquids and free abrasive particles and slurries extensively throughout the patent. Notwithstanding, there is not a single sentence within the patent suggesting a lapping process utilizing a non-abrasive liquid. Consequently, Applicants respectfully submit that the rejection of the present claims as being anticipated by *Dubrovskiy* under §102 is improper and should be withdrawn.

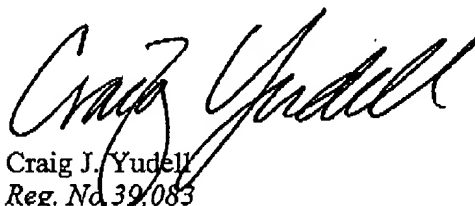
To the extent that there remains any doubt in the Examiner's mind that perhaps a non-abrasive liquid is inherent in the teaching of *Dubrovskiy*, Applicants would respectfully point out that the teaching of *Dubrovskiy* actually teaches away from a process for lapping air bearing surfaces with a non-abrasive liquid. At col. 2, lines 20-42, *Dubrovskiy* describes in detail the prior art and its use of abrasive slurries in lapping processes, and further the use of abrasive particles such as diamond fragments embedded in the rotating lapping plates. At col. 4, lines 22-34, *Dubrovskiy* details their invention as utilizing a slurry of glycol abrasive particles as being held in the textured lapping plate grooves for lapping and polishing of the ABS surface. At col. 5, lines 45-55 and col. 6, lines 36-56, the abrasive slurry is described as an integral part of the lapping process. In fact, *Dubrovskiy* considered the use of a slurry of free particle abrasives so important to their invention that they required such element within the two independent claims (Claims 1 and 3) of their patent.

Applicants respectfully submit that none of these teachings disclose "*dispensing a non-abrasive liquid between the air bearing surface and the lapping plate*". Applicants further respectfully submit that it is not reasonable to consider a non-abrasive liquid as being inherent in the teaching of *Dubrovskiy*, when *Dubrovskiy* clearly teaches away from such a non-abrasive liquid, and instead emphasizes the great importance of a free particle abrasive in both the specification and claims of their invention.

For the reasons given above, Applicants respectfully submit that exemplary Claim 1 in the present application is neither shown nor suggested by the teaching of *Dubrovskiy*, and that the rejection of exemplary Claim 1 under 35 U.S.C. §102(e) as being anticipated by *Dubrovskiy* should be withdrawn. Applicants further submit that "for the reasons given above" Claims 2-5

are also not shown or suggested by the teaching of *Dubrovskiy* and that the rejection of those claims under 35 U.S.C. §102(e) as being anticipated by *Dubrovskiy* should also be withdrawn.

Respectfully submitted,



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